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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,634	04/27/2001	Kazumi Fujii	Q64245	8848

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EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/21/2003

49

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/842,634

Applicant(s)

FUJII, KAZUMI

Examiner

Mark Eashoo, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites the limitation "said groove-like part".

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pedersen (EP D 767 116 A2).

Regarding claim 12: Pedersen teaches the claimed process of forming a disc cable, comprising: molding a disc formed of a first synthetic resin onto a wire/cable, the disc having a radial part extending orthogonal to the wire/cable and a boss part substantially extending along the length of the wire/cable (Fig. 1, element 2); and forming a cover layer of a second synthetic resin on the surface of a wire substantially extending to the radial surface of the disc (Fig. 1, elements 2 and 3) and covering the boss part.

The disc portion of Pedersen has both radial and boss portions. However, since the disc is a unitarily molded part, division into respective portions is an arbitrary and imaginary boundary because the boss tapers into the main radial portion.

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Regarding claim 17: Pedersen further teaches a groove-like part having a length substantially smaller than the disc, including both radial and boss parts (Fig. 1, element 2a).

Regarding claim 13: Pedersen teaches the claimed process of forming a disc cable, comprising: molding a inner layer and flange of a boss part (Fig. 1, portion near element 2b) having a depression (Fig. 1, element 2a) therein which is proximate a radial portion; forming a cover layer of synthetic resin on a preform covering the inner layer of a boss and extending to a radial portion of the disc (Fig. 1, element 3); and forming a protrusion on the cover layer corresponding to the depression (Fig. 1, elements 3a and 2a).

The disc portion of Pedersen has both radial and boss portions. However, since the disc is a unitarily molded part, division into respective portions is an arbitrary and imaginary boundary because the boss tapers into the main radial portion.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pedersen (EP 0 767 116 A2) in view of Winkler et al. (US Pat. 4,373,113).

Regarding claim 9: Pedersen teaches the basic claimed process of forming a disc cable, comprising: forming a cover layer of a first synthetic resin on the surface of a wire (Fig. 1, element 3); and molding a disc formed of a second synthetic resin onto the cable (Fig. 1, element 2).

Pedersen does not teach forming a cover layer on a preform with longitudinally spaced grooves therein and then molding discs such that the disc resin flows into the spaced grooves thereby forming a protrusion on the disc to mount it to the preform. However, Winkler et al. teaches forming a cover layer on a preform with longitudinally spaced grooves therein and then molding discs such that the disc resin flows into the spaced grooves thereby forming a protrusion on the disc to mount it to the preform (Fig. 2, elements 2 and 4). Pedersen and Winkler et al. are combinable because they are concerned with a similar technical difficulty, namely, forming a preform covering mechanically locked to a disc/sleeve. At the time of invention a person having ordinary skill in the art would have found it obvious to have formed a cover layer on a preform with longitudinally spaced grooves therein and then molding

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discs such that the disc resin flows into the spaced grooves thereby forming a protrusion on the disc to mount it to the preform, as taught by Winkler et al., in the process of Pedersen, and would have been motivated to do so because Winkler et al. suggests that molding a cover layer first is an equivalent and alternative means of forming a mechanical interlock between the cover and disc/sleeve.

Claims 14-16: Winkler et al. does not teach a specific groove distance or the distance between the spaced sleeves (element 2, Fig. 1). Nonetheless, it is well known to ensure that mechanically interlocked parts are well connected. At the time of invention, it would have been well within the skill of an ordinary artisan to have determined the optimal size of the groove spacing, through routine experimentation. The motivation for the combination is substantially the same as set forth above regarding claim 1.

Response to Arguments

Applicant's arguments filed 30-SEP-2003, pertaining to claims 9, and 12-17, have been fully considered but they are not persuasive. Response to applicant's arguments have been substantially responded to in the above rejections. For completeness, the following comments apply:

1.) Applicant's argument that Pedersen does not teach the cover layer extending to the radial surface is a matter of arbitrary interpretation because the boss portion tapers and transitions into the radial surface. Furthermore, to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to a mere claiming of a use of a particular structure. *Ex parte Pfeiffer* 135 USPQ 31. Since the function of the cover layer as molded in Pedersen is essentially the same as set forth in claim 12, the specific location where the cover layer terminates on the entire disc structure does not affect the method in a manipulative sense and amounts to a mere claiming of a use of a particular structure.

2.) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., continuous molding) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Allowable Subject Matter

Claim II is allowed.

The following is an examiner's statement of reasons for allowance:

The prior art of record does not teach or render obvious the instantly claimed subject matter as a whole wherein a fitting hole is formed in a disc and a cover layer is fitted into the fitting hole during production of the disc cable. One example of such process is substantially shown in instant Fig. 3.

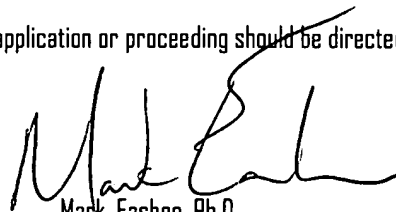
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (703) 308-3606. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaanni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

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